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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/687,157	10/12/2000	John J. Sie	19281-000800US	8624

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EXAMINER

GROSS, KENNETH A

ART UNIT	PAPER NUMBER
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2122

DATE MAILED: 02/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/687,157

Applicant(s)

SIE ET AL.

Examiner

Kenneth A Gross

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2-7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, Claim 9 recites "determining a subset of programs from a larger set of programs" (Claim 9, lines 2-3). It is unclear where this limitation fit into parent Claim 8. Claim 8 refers to only one program, not a set of programs. Does this claim refer to a subset of programs *sent* to the user from a larger set of programs? Clarification is needed.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-3, 8, and 13-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Grapes (U.S. Patent Number 6,446,130).

In regard to Claim 1, Grapes teaches: (a) receiving a command from the content distributor to store the program at the user location (Column 6, lines 42-67); (b) processing the command (Column 7, lines 7-12); (c) receiving the program at the user location (Column 17, lines 1-7); (d) storing the program at the user location in response to at least the processing of the command (Column 15, lines 49-59); and (e) detecting a user action related to the program after storage of the program (Column 13, lines 3-10).

In regard to Claim 2, Grapes teaches that the program comprises a commercial (Column 5, lines 43-44).

In regard to Claim 3, Grapes teaches that the program comprises video and audio programs (Column 5, lines 40-43).

In regard to Claim 8, Grapes teaches: (a) commanding the user location to store the program from the content distributor (Column 17, lines 2-7); and (b) sending the program to the user location for storage before a user requests the program (Column 11, lines 66-67 and Column 12, lines 1-6). The content packages, which have been “predetermined”, are interpreted to be programs put on the queue without user request (hence the line “either predetermined or selected by the user”).

In regard to Claim 13, Grapes teaches broadcasting the program to a plurality of user locations (Column 1, lines 18-20 and lines 54-56).

Claims 14-16 are product claims that correspond to method Claims 1-3, respectively, and are rejected for the same reasons as Claims 1-3, respectively, where Grapes teaches a product for carrying out said method of Claims 4-6 (Figure 1A).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 4-6, 9, 12, and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grapes (U.S. Patent Number 6,446,130) in view of Satterfield (U.S. Patent Number 6,305,017).

In regard to Claim 4, Grapes teaches the method of Claim 1, but does not teach that the user location comprises a set top box. Satterfield, however, does teach transmitting multimedia content to a set top box (Column 1, lines 61-65). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to perform the method of Claim 1, as taught by Grapes, where the user location is a set top box, as taught by Satterfield, since this allows for easy compatibility with a television set, and allows for user-friendly interaction with a remote control.

In regard to Claim 5, Grapes teaches the method of Claim 1, and further teaches storing the program on a mass storage device associated with the computer location (Figure 1A, item 16). Grapes does not teach that the user location comprises a set top box associated with the mass storage device. Satterfield, however, does teach transmitting multimedia content to a set top box (Column 1, lines 61-65). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to perform the method of Claim 1 further storing the program on a mass storage device associated with the computer location, as taught by Grapes, where the user

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location is a set top box associated with the mass storage device, as taught by Satterfield, since this allows for easy compatibility with a television set, and allows for user-friendly interaction with a remote control.

In regard to Claim 6, Grapes teaches the method of Claim 1, but does not teach determining a subset of programs from a linear schedule of programs associated with a content distributor and transmitting the subset to the user location. Satterfield, however, does teach determining and transmitting a linear schedule of programs to the user location (Column 6, lines 22-25). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to perform the method of Claim 1, as taught by Grapes, where the method further includes determining a subset of programs from a linear schedule of programs associated with a content distributor and transmitting the subset to the user location, as taught by Satterfield, since this allows users to browse for a specified program and also allows for an updated listing of programs for users.

In regard to Claim 9, Grapes teaches the method of Claim 8, but does not teach determining a subset of programs from a larger set of programs. Satterfield, however, does teach determining a subset of programs from a larger set of programs (Figure 4).

In regard to Claim 12, Grapes teaches the method of Claim 8, but does not teach that the program is unmentioned in a linear schedule. Satterfield, however, does teach choosing a program that is not on a linear schedule (Column 1, lines 32-40 and Column 2, lines 11-18). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to perform the method of Claim 8, as taught by Grapes, where the program is

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unmentioned in a linear schedule, as taught by Satterfield, since this allows special programs or movies that will not be shown on a regular schedule to be chosen by a user.

Claims 17-19 are product claims that correspond to method Claims 4-6, respectively, and are rejected for the same reasons as Claims 4-6, respectively, where Grapes teaches a product for carrying out said method of Claim 4-6 (Figure 1A).

7. Claims 7, 11, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grapes (U.S. Patent Number 6,446,130) in view of Hall et al. (U.S. Patent Number 5,920,861).

In regard to Claim 7, Grapes teaches the method of Claim 1, but does not teach that processing the command comprises determining usage rules related to the program. Hall, however, does teach using usage rules to determine how a program is to be used and accessed (Column 25, lines 9-15). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to perform the method of Claim 1, as taught by Grapes, further determining usage rules related to the program, as taught by Hall, since this allows access to certain content to be restricted for unauthorized users.

In regard to Claim 11, Grapes teaches the method of Claim 8, but does not teach sending usage rules for the program to the user location. Hall, however, does teach packaging usage rules for a program and sending them to a user with the program (Column 2, lines 21-23). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to perform the method of Claim 8, as taught by Grapes, where the method further includes sending usage rules for the program to the user location, as taught by Hall, since this allows the user to follow these rules for the program at the user location.

Claim 20 is a product claim that corresponds to method Claim 7, and is rejected for the same reasons as Claim 7, where Grapes teaches a product for carrying out said method of Claim 7 (Figure 1A).


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth A Gross whose telephone number is (703) 305-0542. The examiner can normally be reached on Mon-Fri 7:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q Dam can be reached on (703) 305-4552. The fax phone number for the organization where this application or proceeding is assigned is (703) 746-7239.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

KAG



TUAN DAM
SUPERVISORY PATENT EXAMINER